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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SHO-0033	
	Application Number 10/697,039-Conf. #8366	Filed October 31, 2003	
	First Named Inventor Kazuki EMORI et al.		
	Art Unit 3714	Examiner T. Y. Harper	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,211</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> Signature Carl Schaukowitch Typed or printed name (202) 955-3750 Telephone number April 22, 2008 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> form is submitted.</p>			



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kazuki EMORI et al.

Application No.: 10/697,039

Filed: October 31, 2003

For: GAMING MACHINE

Attorney Docket No.: SHO-0033

Examiner: T. Y. Harper

Art Unit: 3714

Confirmation No.: 8366

**ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Claims 1 and 4-28 are rejected under 35 USC 103 (a) as being unpatentable over Matayoshi (JP 2002-035209) in view of Susumu (JP 11-156001 A). The rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. §103, the United States Patent and Trademark Office bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. "A *prima facie* case of obviousness is established if the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." If the Examiner fails to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned.

Examiners must make appropriate rejections regarding the obviousness of claimed inventions in light of the recent Supreme Court's decision in KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 USPQ2d 1385 (2007). The familiar factual inquiries announced by the Supreme Court in its much earlier decision, Graham v. John Deere Co., 383 US 1, 148 USPQ 459 (1966), remain the basis for every decision regarding obviousness, i.e., Examiners will continue to consider:

- (1) the scope and content of the prior art,
- (2) the differences between the claimed invention and the prior art,
- (3) the level of ordinary skill in the pertinent art, and
- (4) objective evidence relevant to the issue of obviousness.

It is respectfully submitted that that none of the applied art, alone or in combination, teaches or suggests the features of claims 1, 11 and 20. Specifically, it is respectfully submitted that the applied art, alone or in combination, fails to teach or suggest a stepped down wall extending generally perpendicularly to a front surface and a bottom wall with a light emission device being attached to the stepped down wall as recited in claims 1, 11 and 20. Thus, it is respectfully submitted that one of ordinary skill in the art could not combine the features of the applied art to arrive at the claimed invention because the applied art is devoid of all the features of the claimed invention. As a result, it is respectfully submitted that claims 1, 11 and 20 are allowable over the applied art.

Based upon the *Graham* factual inquiries, the Examiner must articulate the following:

(a) a finding that the prior art included each element claimed although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(b) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element in the early would have performed the same function as it did separately;

(c) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(d) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

It is respectfully submitted that, with regard to claims 1, 11 and 20, the Examiner has failed to find that the prior art includes each claimed element as required under paragraph (a) set forth above. Specifically, as mentioned above, it is respectfully submitted that the applied art, alone or in combination, fails to teach or suggest a stepped down wall extending generally perpendicularly to a front surface and a bottom wall with a light emission device being attached to the stepped down wall as recited in claims 1, 11 and 20.

In fact, by the Examiner's own admission, the applied art fails to teach the stepped down wall feature as recited in claims 1, 11 and 20. On Page 3, paragraph 2, in the final Office Action, the Examiner, in rejecting the claims, states:

Matayoshi discloses the LED's (40) in various locations as illustrated in Figures 5-11 but fails to disclose the LED's arranged on the stepped down wall on the speaker recess.

As asserted by the Applicants and admitted by the Examiner, none of the prior art, alone or in combination, teaches or suggests a stepped down wall extending generally perpendicularly to a front surface and a bottom wall with a light emission device being attached to the stepped down wall as recited in claims 1, 11 and 20. Therefore, it is respectfully submitted that the Examiner fails to consider all of the claim limitations, especially those that are missing from the applied art.

Further, it is respectfully submitted that since the Examiner has failed to find that the prior art includes each claimed element of claims 1, 11 and 20, paragraphs (b), (c) and (d) of the *Graham* factual inquiries set forth above cannot be satisfied. Therefore, based upon the above, it is respectfully submitted that the Examiner cannot support the *Graham* factual inquiries as required under KSR.

Furthermore, under 35 U.S.C. §103(a), a patent may not be obtained though the invention is not identically disclosed or described. . . . if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter*

as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. . . .

In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988), the Federal Circuit held that a reference did not render the claimed combination *prima facie* because the Examiner ignored a material claimed temperature limitation which was absent from the reference. By analogy, the Examiner has ignored a material claimed feature, i.e., a stepped down wall extending generally perpendicularly to a front surface and a bottom wall with a light emission device being attached to the stepped down wall as recited in claims 1, 11 and 20. The Federal Circuit in this case held want of *prima facie* obviousness in that "the mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that the requirement is in the reference. In re Evanega, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987).

Additionally, it is respectfully submitted that the results and advantages are a part of the claimed invention as a whole. It is a basic tenet of patent law that the U.S. Patent and Trademark Office is not permitted to ignore the results and advantages produced by claimed subject matter, of which the prior art is devoid, simply because the claimed limitations are similar to that otherwise barren prior art. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987); Formson v. Advance Offset Plate, 755 F.2d 1549, 225 USPQ 26 (Fed. Cir. 1985). For instance, on page 4, paragraph 2, in this specification, it states:

According to the configuration, the light source of the light emission means is placed in a sideways position relative to the front of the gaming machine, so that the player is not given the impression that the light source is a light source of point light emission, and the player feels that the full face of the cover emits light. Therefore, the high illumination effect can be provided.

This result and this advantage are not taught or suggested in the applied art.

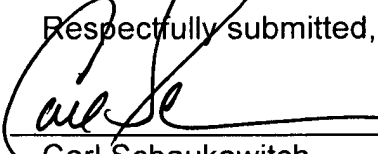
As discussed in previous responses, the subject matter of the claimed invention is to attach the LEDs inside the speaker cover so that the direction of the light source becomes parallel with the front face of the cabinet as reflected by the claim language "a light emission device... attached to the stepped down wall" as recited in claims 1, 11 and 20. The stepped down wall is a side wall of the recess and is not a bottom wall. This feature is illustrated in Figure 5 and supported in the specification on page 9, paragraph [0019] which reads, in part, as follows:

An LED board 2106e is attached to a stepped part 2110d of a recess 2110 where a part of the speaker main unit 2108 is exposed, and white LEDs 2106a to 2106d are disposed on the LED board 2106e (shown in FIG. 5). The face of the stepped part 2110d is roughly perpendicular to the front of the cabinet and the bottom of the recess 2110.

For at least the reasons discussed above, it is respectfully submitted that none of the cited references, alone or in combination, teaches or suggests this feature.

The dependent claims depend from their respective independent claims and include all of the features of the respective independent claims. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason the independent claims are allowable as well as for the features they recite.

Date: April 22, 2008

Respectfully submitted,  
  
By: Carl Schawkowitch  
Reg. No. 29,211

**RADER, FISHMAN & GRAUER PLLC**  
1233 20<sup>th</sup> Street, N.W. Suite 501  
Washington, D.C. 20036  
Tel: (202) 955-3750  
Fax: (202) 955-3751  
Customer No. 23353

Enclosure(s): Notice of Appeal  
Pre-Appeal Brief Request for Review  
Petition for Extension of Time (two months)

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